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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,200

10/28/2005

Giovanni De Toni

2512-1146

4450

466

7590

10/01/2007

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EXAMINER

SLOMSKI, REBECCA

ART UNIT

PAPER NUMBER

2877

2

MAIL DATE

DELIVERY MODE

10/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,200

Applicant(s)

DE TONI ET AL.

Examiner

Rebecca C. Slomski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 17 and 22 is/are rejected.
- 7) ☒ Claim(s) 16, 18-21 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/17/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the term "security support" is misleading. Although clearly defined in the specification on page 1, paragraph 2, the definition is in contrast to the generally understood term "security support". The term should be changed in order to better describe the invention.

Appropriate correction is required.

2. The title of the invention is not properly descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Inspecting system for security documents"

Claim Objections

3. Claims 15-22 and 29 are objected to because of the following informalities: the term "security support" is misleading. Although clearly defined in the specification on page 1, paragraph 2, the definition is in contrast to the generally understood term "security support". The term should be changed in order to better describe the invention.

Appropriate correction is required.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: label 20 as shown in Figure 4A.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "5" has been used to designate both the camera and the cone in Figure 4B.
6. The drawings are objected to because on second page of drawing sheets, it is unclear where the separation is between Figures 2 and 3.
7. Additionally, the following labels are unclear as to what item in the drawing they are directed to:
 - Figure 5, labels 3 and 11
 - Figure 6, labels B and 11
8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between "a transparency inspecting device" and the "electromagnetic inspecting beam" and the "image acquiring device." The transparency inspecting device is not further defined in the specification.
10. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the phrase "correspondence of sensitive elements" means.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Belluche U.S. Patent # 2,567,049.

11. With respect to claim 15, Belluche et al. discloses an apparatus for inspecting a printed sheet comprising:

- A transportation device is apt to transport said thin support past an image acquiring device (Col.2, L 14-23, thin support = printed sheet, image acquiring device = operator of the machine)
- Transportation device is a rotating cylinder provided with transparent sectors of a size at least equal to that of the portion of the security support to be inspected (Col.6, L 7-12)
- A transparency inspecting device is placed partially inside and partially outside the cylinder so that the electromagnetic inspecting beam is intercepted by said supports held lying onto said transparent sectors (Col.5, L 20-23, Figure 4, Col.2, L 14-23)

- Transportation cylinder comprises a gripping system for said security support having a pivoting gripping element cooperating with at least a radially movable block (Figure 6, pivoting gripping elements = spring fingers 38, radially movable block = eccentrics 41)
- The gripping point of the security support being able to be lowered relative to the nominal rotational diameter thereof so as not to interfere with calibration blades (Col.5, L 74-Col.6, L 6, Col.9, L 41-50, Figure 1, gripping point =free ends 40, calibration blades = side register devices 94', wherein gripping points to do not interfere with calibration blade responsible for aligning printed sheet)
- Calibration blades fixedly placed in proximity of the inspection axis and strictly adjacent to said rotating cylinder (Figure 1, calibration blades = side register devices 94')

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belluche U.S. Patent #2,567,049 in view of Haslop et al. U.S. Patent #4,296,326.

12. With respect to claim 17, Belluche discloses all of the limitations as applied to claim 15 above. However, Belluche fails to disclose an optical path comprising a lens and a shading means.

Haslop et al. discloses a watermark detection device comprising:

- An optical path defined between an illuminating device and an acquisition camera (Figure 1, illuminating device = light source 20, acquisition camera = photomultiplier PM³)
- Comprising a lens which focuses the light source onto a focal point through which thin security support is made to pass as a target (Figure 1, lens = optical system 21, thin security support = banknote N)
- Along the optical path at or upstream of said lens shading means being provided (Figure 1, shading means = light guide 19)

It would have been obvious to one of ordinary skill in the art at the time the invention was conceived to define the optical path as in Haslop et al. in the apparatus of Belluche since providing a lens is a well known method of focusing light in order to increase efficiency and control the output. Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was conceived to provide a shading means

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for the detector in order to control the light reaching the detector and prevent flooding and ambient light from deteriorating the inspection, prolonging the life of the detector.

It has been held that the recitation that an element is "apt to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

13. With respect to claim 22, Belluche in view of Haslop et al. disclose all of the limitations as applied to claims 15 and 17 above. In addition, Belluche et al. discloses:

- illuminating device has reflecting surfaces at its side ends (Col. 12, L 43-45, Figure 17)

Allowable Subject Matter

14. Claims 16, 18-21, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

- With respect to claim 16, the prior art taken alone or in combination fails to disclose or render obvious a thin removable transparent protective layer on the transparent sectors of the cylinder in combination with the rest of the limitations.
- With respect to claim 18-20 and 29, the prior art taken alone or in combination fails to disclose or render obvious shading means is a semitransparent material which prevents the camera from exceeding a saturation threshold in combination with the rest of the limitations.

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- With respect to claim 21, the prior art taken alone or in combination fails to disclose or render obvious shading means is transparent and sized so as not to absorb more than 10% of the light intensity in combination with the rest of the limitations.

Citation

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Polidoro et al. U.S. Patent #5,720,376 discloses a document handling system
- Sontheimer U.S. Patent #2,731,621 discloses a counterfeit detector
- Chistophersen et al. U.S. Patent #7,266,231 method and apparatus for identifying documents

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca C. Slomski whose telephone number is 571-272-9787. The examiner can normally be reached on Monday through Thursday, 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on 571-272-2059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

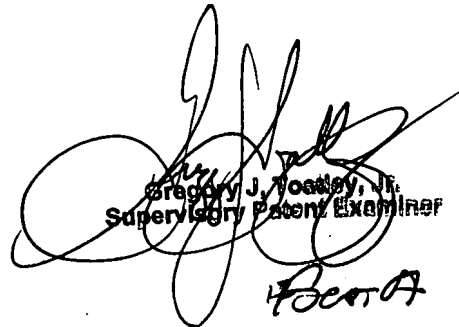
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Assistant Patent Examiner

rcs



Gregory J. Tostley, Jr.
Supervisory Patent Examiner